

### **REMARKS**

Claims 1-42, 44 and 46-67 are currently pending in the subject application and are presently under consideration. A version of the claims is at pages 2-16. Claims 1, 15, 24, 30, 32, 40, 42, 44, 46-54, 58, 59 and 64-67 have been amended herein. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

#### **I. Rejection of Claims 15-23, 46, 50, 51, 58, 59 and 67 Under 35 U.S.C. §101**

Claims 15-23, 46, 50, 51, 58, 59, 67 stand rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. In view of the amendments to claims 15, 46, 50, 51, 58, 59 and 67, this rejection is now moot and should be withdrawn.

#### **II. Rejection of Claims 1-11, 15-21, 24-25, 27-36 and 38-67 Under 35 U.S.C. §103(a)**

Claims 1-11, 15-21, 24-25, 27-36, 38-67 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ellis *et al.* (US 2005/0028208) in view of Arsenault *et al.* (US 6,701,528). This rejection should be withdrawn for at least the following reasons. The cited references, either alone or in combination, do not teach or suggest all aspects of the subject claims.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. ***Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.*** See MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the

prior art and not based on applicant's disclosure. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The claimed invention relates to a system for providing program criteria to facilitate recording of a specific audio and/or visual program. In particular, independent claims 1, 24, 30, 32, 40, 42, 44, 46, 51 and 59 recite similar limitations, namely a system for providing program criteria comprising a server computer storing a plurality of tokens, ***at least two of the plurality of tokens each associated with a disparate one of at least two segments of a predetermined one of an audio and visual program***; wherein the server is programmed to provide at least one token to a remote computer based on received selection criteria, ***the remote computer utilizes at least two tokens to selectively combine at least two program segments based at least in part upon viewing characteristics of one or more users at the remote computer, the viewing characteristics comprising at least one of an age of the one or more users, time of day and type of show being viewed***. *Ellis et al.* and *Arsenault et al.* are silent regarding such novel aspects of the claimed invention.

*Ellis et al.* relates to an interactive television program guide system with remote access. As conceded by the Examiner in the Office Action, *Ellis et al.* does not teach or suggest at least two program segments each associated with a disparate token; therefore, *Ellis et al.* is further silent with regard to the selective combining of the at least two program segments in the manner achieved by amended independent claims 1, 24, 30, 32, 40, 42, 44, 46, 51 and 59.

*Arsenault et al.* does not compensate for the aforementioned deficiencies of *Ellis et al.* *Arsenault et al.* relates to providing more efficient video on demand services. The cited reference assembles segments for video playback upon user demand; however, the reference is not directed towards ***combining at least two program segments based at least in part upon viewing characteristics of one or more users at the remote computer, the viewing characteristics comprising at least one of an age of the one or more users, time of day and type of show being viewed***, as afforded by the subject claims. Rather, *Arsenault et al.* provides a system for local caching of an initial segment of an audio or video program prior to the system receiving an audio or video program selection. The

cited reference employs such pre-caching of an initial segment to mitigate potential latencies of audio and visual program transmission during high-traffic periods. However, the cited reference does not contemplate allowing for re-arranging of a plurality of program segments during playback according to characteristics of a user. Thus, for example, the reference does not allow for dynamic customization of advertisements during playback of a corresponding program based on age of user, time of day and type of show. Consequently, Arsenault *et al.* does not teach or suggest ***a remote computer utilizes at least two tokens to selectively combine at least two program segments based at least in part upon viewing characteristics of one or more users at the remote computer, the viewing characteristics comprising at least one of an age of the one or more users, time of day and type of show being viewed***, as recited by the subject claims.

In view of at least the foregoing, it is readily apparent that the cited references do not teach or suggest all aspects of the subject claims. Accordingly, this rejection should be withdrawn.

### **III. Rejection of Claims 12-14, 22-23, 26, 37 Under 35 U.S.C. §103(a)**

Claims 12-14, 22-23, 26, 37 stand rejected under 35 U.S.C. §103(a) as being unpatentable over E208 in view of Arsenault as applied to claim 11, 15, 25, or 36 above, and further in view of Knudson *et al.* (US 6,536,041). This rejection should be withdrawn for at least the following reasons. The subject claims respectively depend from independent claims 1, 15, 24 and 32. As noted above, Ellis *et al.* and Arsenault *et al.* do not teach or suggest all aspects of independent claims 1, 15, 24 and 32 (from which the subject claims depend from); and Knudson *et al.* does not make up for such deficiencies of the primary references. Accordingly, this rejection should be withdrawn.

**CONCLUSION**

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP131US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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